

REMARKS

Claims 25-37 are pending.

Claims 25-37 are *provisionally* rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 23-44 of copending Application No. 10/802,613.

Claims 25-37 are rejected as being obvious over US 6,223,143 to Weinstock et al. in view of US 2005/0060213 to Lavu et al. further in view of US 7,003,439 to Aldred et al.

Standard of Review

Obviousness

"If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention as a blueprint for piecing together elements in the prior art to defeat patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.'" *In re Rouffet*, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998) citing *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

"The U.S. Supreme Court recently held that rigid and mandatory application of the 'teaching-suggestion-motivation,' or TSM, test is incompatible with its precedents. *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 82 USPQ2d 1385 (2007). The Court did not, however, discard the TSM test completely; it noted that its precedents show that an invention 'composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.' *Id.*" *Ex parte Whalen*, 89 USPQ2d 1078, 1084 (BPAI 2008).

"The Court held that the TSM test must be applied flexibly, and take into account a number of factors 'in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed.' *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. at 1740-41.

Despite this flexibility, however, the Court stated that 'it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements in the way the claimed new invention does.' *Id.* "To facilitate review, this analysis should be made explicit." *Ex parte Whalen*, 89 USPQ2d at 1084.

"[R]jections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness". *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007) citing with approval *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006).

"The *KSR* Court noted that obviousness cannot be proven merely by showing that the elements of a claimed device were known in the prior art; it must be shown that those of ordinary skill in the art would have had some 'apparent reason to combine the known elements in the fashion claimed.'" *Ex parte Whalen*, 89 USPQ2d at 1084 citing *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. at 1741.

"A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teaching of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)." MPEP 2143.01(IV).

"[An examiner's] opinions regarding the benefit are "not 'evidence.'" *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (citing *McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993); *In re Sichert*, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977))." *Ex Parte Kazuhiko Hayashi, Shigeru Mori, And Masafumi Nakada*, 2004 WL 4978612, Appeal No. 2002-1701 (Bd. Pat. App. & Int., February 26, 2004).

Discussion

Claim 25 is amended herein to address grammar issues resulting from the prior amendments. No new matter is added.

Applicant respectfully submits that a *prima facie* showing of obviousness has not been provided. Weinstock et al. discloses a Quantitative Risk Assessment System (QRAS) and Lavu et al. discloses a management system. Aldred et al. is directed to forecasting drilling events and drilling hazard information. In support of combining the cited documents, the Examiner provides the conclusory statement: "Given Weinstock and Lavu's general tool and the known risks to wellbore design taught by Aldred, it would have been obvious to one of ordinary skill in the art at the time of the invention to apply Weinstock's and Lavu's general risk assessment methods to the art of wellbore design as a means of assessing risk prior to drilling to avoid undesirable consequences of failing to anticipate risks of any particular drilling plan."

The systems and methods described in each of the cited documents are complete as disclosed and do not teach or suggest combining features in the manner claimed by Applicant. In particular, Aldred et al. provides a system and method for ranking drilling hazards associated with drilling events that is distinct from the method claimed by Applicant and does not suggest modification.

Further, the cited documents, singularly and in combination, fail to disclose each of the features recited in Applicant's independent claim 25 and the combination does not disclose the claimed features in the manner recited by Applicant. For example, the cited documents fail to disclose displaying risk information that is generated in response to ranked risk values generated in response to ranking input data calculation results by logical expression as recited by Applicant in independent claim 25. It is therefore respectfully requested that the rejections be withdrawn.

Serial No. 10/802,524
Reply Dated 08/20/2009
Reply to Communication of 06/15/2009

The provisional non-statutory obviousness type double patenting rejection will be addressed upon withdrawal of the 103 rejection. The Examiner is invited to contact Applicant's representative upon withdrawal of the pending 103 rejection to expedite a resolution to the provisional double patenting rejection.

Respectfully submitted,
WINSTEAD PC

August 20, 2009
DATE

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